

# MEMORY TRANSMISSION REPORT

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TEL NUMBER2: 9494501765  
E-MAIL :  
NAME : Stout,Uxa,Buyan & Mullins

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## FACSIMILE COVER PAGE

DATE: 6/13/2003  
TO: PTO Petitions Office  
FAX: 703-308-6916  
FROM: Don Stat  
RE: SN 08/482,402

THIS TRANSMISSION CONSISTS OF 15 PAGES INCLUDING THIS COVER PAGE.  
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- 1) Submittal of Copy of Petition (2 pages)
- 2) Petition for Reconsideration, including Exhibits A & B (11 pages)
- 3) Copy of Return Receipt Postcard

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application:	/	
Rapoport	/	allowed: 05/01/2002
U.S. Serial No. 08/482,402	/	batch: 2315
CPA Filed: 06/07/95	/	
For: <b>DISEASE ASSOCIATED HUMAN AUTOANTIBODIES SPECIFIC FOR HUMAN THYROID PEROXIDASE</b>	/	Group Art Unit: 1642
	/	Examiner: S. Ungar
	/	

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUBMITTAL OF COPY OF PETITION FOR RECONSIDERATION OF PETITION  
DECISION**

Dear Sir:

Today, Ms. R. C. Tang telephoned the undersigned, indicating that Mr. William Dixon had forwarded a prior petition, originally filed on January 14, 2003, to her for review, and that she did not see, based upon a perusal of that petition, any reason to change the determination made in the Petition Decision of May 7, 2003, holding the subject application abandoned.

Responsive to Ms. Tang's comments, the undersigned explained that there was another petition pending, which was received in the PTO on May 16, 2003, which requests reconsideration of the May 7 Petition Decision. She stated that there was no copy of that petition in the file, and requested that a copy be faxed directly to the Petitions Office to be matched with the file.

Accordingly, a copy of the May 16 petition, together with a copy of the stamped return receipt postcard indicating its original receipt in the PTO on May 16, 2003, is attached hereto.

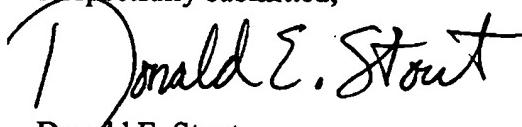
During our conversation, Ms. Tang expressed concerns that a petitions examiner would have no basis for reversing the prior decisions rendered by the Group Director, absent new facts.

Responsive to her concerns, the undersigned pointed out that no decision was rendered on the January 14 petition, which introduced the new fact that the PTO has accepted the issue fee, charging it to our deposit account, for the subject application. Furthermore, the May 16 petition sets forth the proposition that when the PTO charged the issue fee to the deposit account, it was responding, in its own time, to the timely submitted issue fee transmittal authorization. The PTO is authorized, though not required, to attempt to charge a fee to a deposit account a second time, and in this instance it chose to do so. Thus, at the point in time when the issue fee was charged, the application was *de facto* no longer abandoned. We believe that this is a correct interpretation of the rules.

Moreover, as a second, alternative basis for granting the petition, the Applicant requests waiver of the rules under 37 CFR 1.183. Mr. Dixon himself suggested this approach. Since the Group Director never previously decided the issue on this basis, the Petitions Examiner clearly would not be overriding the Group Director. In fact, Mr. Dixon informed the undersigned that he had no authority to decide matters under 37 CFR 1.183.

Please feel free to contact the undersigned to further discuss any of the foregoing.

June 13, 2003  
Stout, Uxa, Buyan & Mullins, LLP  
4 Venture, Suite 300  
Irvine, CA 92618  
949-450-1750 *telephone*  
949-450-1764 *facsimile*

Respectfully submitted,  
  
Donald E. Stout  
Registration No. 34,493

The U.S. Patent & Trademark Office affixes its stamp or affixes hereon  
acknowledges receipt of the documents indicated below.

Applicant

Rapoport

A-1677

U.S. Serial No.

08/482,402

Docket No. 102105.151

Filed

6/7/95

Title/Mark

Disease associated w/human...

Date Mailed

5/13/03

Date Due

enclosed herewith

Patent Application \_\_\_\_\_ pgs \_\_\_\_\_ claims  transmittal  dep. acct. authorization

Provisional Patent Application \_\_\_\_\_ pgs  transmittal  dep. acct. authorization

Trademark/Servicemark Application  transmittal letter  dep. acct. authorization

specimen(s)  Statement of Use  Amendment to Allege Use

Drawings: \_\_\_\_\_ sheet(s)  Informal  formal & transmittal

Check No.: \_\_\_\_\_ in the amount of \$ \_\_\_\_\_

Declaration and/or Power of Attorney

Assignment  Recordation Cover  dep. acct. authorization

Small Entity Status form(s)  an individual  a small business

Response to Notice to File Missing parts of Application

Amendment/Response  transmittal  dep. acct. authorization

Information Disclosure Statement  form PTO1449  copies of references

Issue Fee transmittal  dep. acct. authorization

Status Inquiry

NASA Declaration

(5 pages)

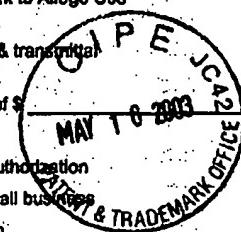
X Petition for Reconsideration of Petition Decision

X Exhibit A (2 pages)

X Exhibit B (3 pages)

Certificate of Mailing  Express Mail  first class mail

DES



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application: /  
Rapoport / allowed: 05/01/2002  
U.S. Serial No. 08/482,402 / batch: 2315  
/ CPA Filed: 06/07/95 / Group Art Unit: 1642  
For: **DISEASE ASSOCIATED HUMAN** /  
**AUTOANTIBODIES SPECIFIC FOR** /  
**HUMAN THYROID PEROXIDASE** / Examiner: S. Ungar

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION FOR RECONSIDERATION OF PETITION DECISION**

Dear Sir:

This is a petition for reconsideration of the petition decision mailed on May 7, 2003.

On July 24, 2003, the Patent & Trademark Office (PTO) received an issue fee transmittal filed by Applicant, authorizing the PTO to charge the issue fee to Deposit Account 13-5135. The issue fee was due on August 1, 2002, so the issue fee transmittal was timely filed.

On September 20, 2002, two months after the issue fee was paid, Applicant received a Notice of Abandonment dated September 16, 2002, which indicated only that the subject application was abandoned for failure to pay the issue fee. No explanation was provided as to the basis for this decision. Consequently, Applicant assumed that the issue fee transmittal filed on July 24, 2002 had been misdirected, or otherwise not matched with the application, and promptly filed a Petition for Reinstatement of Improperly Abandoned Application on October 1, 2002. This petition merely explained that the Notice of Abandonment was mistaken, since the issue fee

transmittal had indeed been filed, and included a copy of the issue fee transmittal, together with a copy of the return receipt postcard, evidencing its timely filing.

Immediately upon the filing of this petition, on October 3, 2002, the issue fee for the subject application, in the amount of \$1,280, was charged to the aforementioned deposit account. A copy of the Deposit Account Statement evidencing this charge is attached hereto as Exhibit A.

**Surprisingly, TWO MONTHS AFTER THE ISSUE FEE HAD BEEN CHARGED TO THE DEPOSIT ACCOUNT OF THE UNDERSIGNED, a Petition Decision was issued on December 2, 2002, denying Applicant's petition of October 1, 2002 and maintaining the abandoned status of the subject application, on the basis that there had been insufficient funds in the authorized deposit account on the date on which the PTO had attempted to charge the authorized issue fee.** It was therefore held that the issue fee had not been timely paid. This was the first time, almost **FIVE MONTHS AFTER THE ISSUE FEE WAS INITIALLY AUTHORIZED, Applicant had been advised of the facts and circumstances which had actually caused the application to be initially abandoned. The Petition Decision never referenced the fact that, two months earlier, the PTO had proceeded to charge the issue fee to the undersigned's deposit account, which charge has never been reversed. In fact, it incorrectly stated that "Applicant resubmitted the Issue Fee on October 1, 2002, however this was after the due date for payment thereof". Applicant never, in fact, resubmitted the Issue Fee. The submittal of October 1, 2002 was merely a request for vacating the holding of abandonment, because the Issue Fee had been timely paid. A copy of the originally submitted Issue Fee was enclosed to back up that contention.**

Applicant filed a request for reconsideration on December 27, 2002, and subsequently filed a second request for reconsideration on January 14, 2003. The second request for reconsideration was prompted when the undersigned became aware, through inspection of deposit account statements, that the PTO was continuing to hold the subject application abandoned while it had

in fact also accepted payment of the issue fee. Strangely, the Petition Decision of May 7, 2003, which took another FOUR MONTHS to render, does not even reference the second request for reconsideration, a copy of which is attached hereto as Exhibit B, and responds only to the first request of December 27, 2002. Again, in the Petition Decision of May 7, it is incorrectly stated that Applicant "resubmitted the Issue Fee on October 1, 2002". It is clear that the decider of the petition never fully reviewed the file, and certainly never considered the submittal of January 14, 2003.

Applicant requests relief from the Petition Decisions of December 2, 2002 and May 7, 2003, holding the subject application abandoned, on one of two alternative bases. The first basis is that the Petition Decision of December 2, 2002 was moot, and thus improper. When the request for withdrawal of the holding of abandonment was filed on October 1, 2002, the PTO responded by immediately charging the Issue Fee to the undersigned's deposit account. This was an affirmative action on the part of the PTO, withdrawing the abandonment status of the subject application, by charging the Issue Fee, which was authorized to be charged prior to the deadline of August 1, 2002 (and not later, in a "resubmittal", as wrongly stated by the decider of the petition), to the deposit account of the undersigned. It is up to the PTO to determine when the issue fee is to be charged to the deposit account, and there is nothing in the rules to prevent the PTO from resubmitting a charge to the deposit account more than once. The rule cited in the Petition Decision of May 7, 2003, namely 37 CFR 1.25, while stating that charges to accounts with insufficient funds will not be accepted, certainly does not prohibit the PTO from attempting to charge the originally authorized fee a second time. In this case, the PTO determined to charge the Issue Fee, which was properly authorized within the allowable period, prior to August 1, 2002, a second time, which was successful.

Thus, since the subject application had already been restored from an abandoned status, by the PTO's action in accepting the Issue Fee on October 3, 2002, the Petition Decision of December 2, 2002 was moot. Similarly, the Petition Decision of May 7, 2003 is also moot. The application is not abandoned.

When the undersigned discussed this matter with Mr. Dixon today by telephone (and Mr. Dixon is thanked for his graciousness during that conversation), he indicated that he had no authority to decide that the subject application is not abandoned, because such a decision would require a waiver of the rules. Presumably he referred to 37 CFR 1.25. Although the undersigned attempted to explain the above rationale, and that no waiver of any rule was required in order to ascertain that the application is not in fact abandoned, he insisted that a petition under 37 CFR 1.183, asking for waiver of the rules, would be necessary, and suggested that one be filed. Accordingly, in the alternative, to the extent necessary, Applicant respectfully requests such a rule waiver in order to arrive at a holding that the subject application is not abandoned, that the Issue Fee has been paid, and that a patent should issue thereon as soon as practicable. The basis for such a ruling is that, regardless of the admitted initial error that the undersigned made in failing, for a few days, to have sufficient funds in the authorized deposit account to permit payment of the Issue Fee, the PTO has made repeated and compounded errors since then, and caused extreme delay in processing this matter, to Applicant's detriment. Initially, there is no excuse for a delay of two months in issuing the initial Notice of Abandonment. There is no excuse for not providing notice, in or prior to the Notice of Abandonment, as to the specific reason why it had been determined that the issue fee had not been paid (i.e. the insufficient funds in the deposit account). There is no excuse for subsequently charging the issue fee to that same deposit account, seven months ago, if the application were not to be restored to active status. There is no excuse for a further delay of two months in rendering the Petition Decision of

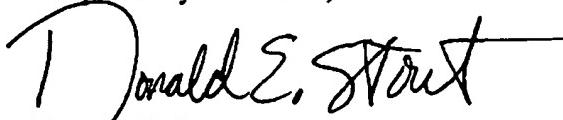
December 2, 2002. Finally, there is no excuse for the further delay, until May 7, 2003, in rendering the second Petition Decision, and then not even considering the submittal of January 14, 2002 in that decision. The PTO encourages Applicants to use deposit accounts, and touts its efforts to provide "customer service", and then exacts completely harsh and punitive penalties when an administrative error is made by an Applicant (in this case a demand for an additional \$1,300 fee for reviving the application and the loss of a year of patent term for the Applicant). Yet the PTO excuses its own repeated gaffes and failures and takes absolutely no responsibility for them, refusing to take any reasonable corrective action. Private companies which operated in such a manner would be immediately shut down.

Accordingly, simple equity requires that this application be restored from its present abandoned status. Applicant further respectfully requests that a decision on this petition, and subsequent issuance of a patent based on this application be expedited in view of the long delays which have occurred as a result of PTO inaction.

Authorization is hereby given to charge any necessary fees, including any fee required in connection with a petition under 37 CFR 1.183, to Deposit Account No. 13-5135.

Please feel free to contact the undersigned to further discuss any of the foregoing.

Respectfully submitted,

  
Donald E. Stout  
Registration No. 34,493

May 13, 2003  
Stout, Uxa, Buyan & Mullins, LLP  
4 Venture, Suite 300  
Irvine, CA 92618  
949-450-1750 *telephone*  
949-450-1764 *facsimile*



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### Deposit Account Statement

**Requested Statement Month:** October 2002  
**Deposit Account Number:** 135135  
**Name:** STOUT UXA BUYAN & MULLINS L L P  
**Attention:** DONALD E. STOUT  
**Address:** 4 VENTURE, SUITE300  
**City:** IRIVINE  
**State:** CA  
**Zip:** 92618

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DATE SEQ	POSTING REF	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
10/03 7	09561480	A-1529	2251	\$55.00	\$8,128.00
10/03 350	08482402	102105.151CI	1501	\$1,280.00	\$6,848.00
10/03 351	09035202	A-1367	1501	\$1,280.00	\$5,568.00
10/03 352	09634118	QD1-1700 DIV	1501	\$1,280.00	\$4,288.00
10/03 353	09931727	A-1661	1501	\$1,280.00	\$3,008.00
10/03 354	09791080	A-1383CON	2501	\$640.00	\$2,368.00
10/03 355	09246342	8388.24P	1501	\$1,280.00	\$1,088.00
10/04 50	10262420	A-1597CON2	2001	\$370.00	\$718.00
10/07 1	10100245	A-1011DIV	2251	\$55.00	\$663.00
10/08 4	09475495	A1579	2251	\$55.00	\$608.00
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10/16 1	09687185	A-1673	2252	\$190.00	\$4,508.00
10/17 150	78175077		7001	\$325.00	\$4,183.00
10/17 322	78175173		7001	\$325.00	\$3,858.00
10/23 10	09954505	A-1804CIP	1814	\$110.00	\$3,748.00
10/25 38	E-REPLENISHMENT		9203	-\$3,000.00	\$6,748.00
10/29 2	09479393	A-1583	2251	\$55.00	\$6,693.00
10/29 26	09226418	A-1670	1453	\$1,280.00	\$5,413.00

START BALANCE	SUM OF CHARGES	SUM OF REPLENISH	END BALANCE
\$8,183.00	\$10,770.00	\$8,000.00	\$5,413.00